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EXAMINER

NUTTER, NATHAN M

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSE M. SOSA and BILLY J. ELLIS

Appeal 2010-002010
Application 10/674,224
Technology Center 1700

Before JEFFREY T. SMITH, MICHAEL P. COLAIANNI, and
RAE LYNN P. GUEST, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1 through 9 and 12 through 27. We have jurisdiction under 35 U.S.C. § 6.

Appellants' claimed invention relates to "a process of preparing HIPS [high impact polystyrene], wherein a rubber and styrene monomer are admixed in the presence of at least two polymerization initiators and polymerized to form high impact polystyrene." App. Br. 3. Claim 1 is illustrative:

1. A process for preparing a high impact polystyrene comprising admixing a rubber and styrene monomer in the presence of at least two polymerization initiators and polymerizing the styrene wherein at least one of the at least two polymerization initiators is a grafting initiator and at least one of the at least two polymerization initiators is a non- grafting initiator.

The Examiner relied on the following references in rejecting the appealed subject matter:

Kamath	US 4,125,695	November 14, 1978
Sosa	US 4,861,827	August 29, 1989
Schrader	US 5,428,106	June 27, 1995

Appellants request review of the following rejections from the Examiner's final office action:

1. Claims 1, 3-6, 8,9, 13-15, 22, 25 and 27 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kamath.
2. Claims 1, 3-5, 8,9, 13-20 and 24-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Sosa.

3. Claims 2, 6-7, 12, 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sosa, as applied to claims 1, 3-5, 8,9, 13- 20 and 24-27 above, and further in view of Schrader.

OPINION

As a preliminary matter, our review of the Examiner's analysis requires that the claims must first be construed to define the scope and meaning of each contested limitation. *See Gechter v. Davidson*, 116 F.3d 1454, 1457 (Fed. Cir. 1997). During prosecution before the Examiner, the claim language should be given its broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account any definitions or enlightenment contained in the written description of Appellants' Specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). "[T]he specification 'is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.'" *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) (en banc).

Applying the preceding legal principles, we determine that the subject matter of independent claim 1 is directed to a process for preparing a high impact polystyrene comprising admixing and polymerizing a rubber and styrene monomer in the presence of at least one grafting initiator and at least one non-grafting initiator. The specification discloses that the "grafting polymerization initialization initiator is one that promotes both the initialization of styrene and the reaction of styrene or polystyrene with the residual unsaturation in a dissolved rubber." Spec. 5. The specification also discloses that "a non-grafting polymerization initialization initiator is one that promotes the initialization of styrene, but does not materially promote

the reaction of styrene or polystyrene with the residual unsaturation in a dissolved rubber.” *Id.*

Rejection under 35 U.S.C. 102(b)/ 35 U.S.C. 103(a) over Kamath

The dispositive issue on appeal for this rejection: Did the Examiner err in determining that Kamath describes a process for preparing a high impact polystyrene comprising admixing and polymerizing a rubber and styrene monomer in the presence of at least one grafting initiator and at least one non-grafting initiator, as required by independent claims 1, 25 and 27? ¹

We answer this question in the affirmative.

We REVERSE.

With respect to the anticipation rejection over Kamath, the Examiner bears the initial burden of establishing a prima facie case of anticipation. *In re King*, 801 F.2d 1324, 1326-27 (Fed. Cir. 1986). Anticipation under 35 U.S.C. § 102 requires that “each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999).

The Examiner found that Kamath discloses a process for polymerizing a styrene monomer with an elastomer (rubber) “in the presence of the initiator system containing at least two initiators.” Ans. 4. The Examiner further found that Kamath discloses initiators “readable” on the claimed grafting and non-grafting initiators. Ans. 5. The Examiner concludes that “[i]t is burden on the applicants to provide the difference in order to overcome this rejection under *In re Fitzgerald* 205 USPQ 594.” Ans. 6.

Appellants contend Kamath does not teach “the use of a grafting initiator and a non-grafting initiator” but instead “teaches the use of two

¹ We will limit our discussion to independent claim 1.

non-grafting initiators” or “the combination of grafting initiators.” App. Br. 4. Appellants further argue that Kamath does not “provide a certain degree of precision with respect to the specific compound[s] claimed.” App. Br. 5.

While the Examiner responds that Kamath teaches a wide variety of initiators (Ans. 9) and an initiator system combining two different types of initiators (Ans. 10), the Examiner does not adequately address Appellants’ arguments above. The Examiner has not adequately explained why the initiator system of Kamath would have necessarily contained the different types of initiators that are required by the claimed invention. In addition, the Examiner has not directed us to evidence or provided analysis to support a finding that the initiator system of Kamath was the same as that which is required by claim 1, given Appellants’ definition for grafting and non-grafting initiators. The Examiner’s rejection appears to be based on the premise that a person of ordinary skill in the art could have selected the proper combination of initiators from the disclosure of Kamath. This is not the proper standard for an anticipation rejection. A claim is not anticipated by a reference when such independent picking and choosing is required to arrive at the claimed invention. *See In re Arkley*, 455 F.2d 586, 587 (CCPA 1972).

Under these circumstances, we cannot conclude that the Examiner has met the minimum threshold of establishing anticipation under 35 U.S.C. § 102(b).

We also cannot sustain the Examiner’s alternative rejection under 35 U.S.C. § 103(a) over Kamath. During examination, the Examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). The Examiner has provided

no reasoning or analysis to support an obviousness rejection under 35 U.S.C. § 103(a).

Therefore, the rejection of claims 1-6, 8-12, 14-17, and 29-44 under 35 U.S.C. § 102(b) and, alternatively, § 103(a) is reversed.

Rejections over Sosa

The rejection under 35 U.S.C. 102(b) over Sosa fails for similar reasons discussed above. We agree with Appellants that Sosa does not teach or suggest “combining a grafting initiator and a non-grafting initiator, such initiators selected to optimize a high impact polystyrene morphology, as recited in pending claim 25.” App. Br. 6.

Likewise, the rejection under 35 U.S.C. 103(a) over Sosa and Schrader also fails because, as argued by Appellants, “*Schrader* does not supply the features missing in Sosa.” App. Br. 6.

Accordingly, we REVERSE these rejections as well.

ORDER

The rejection of claims 1, 3-6, 8-9, 13-15, 22, 25 and 27 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kamath is reversed.

The rejection of claims 1, 3-5, 8-9, 13-20 and 24-27 under 35 U.S.C. 102(b) as being anticipated by Sosa is reversed.

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The rejection of claims 2, 6-7, 12, 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sosa and Schrader is reversed.

REVERSED

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